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30636 7590 04/30/2008 FAY KAPLUN & MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038				
EXAMINER				
MITCHELL, JASON D				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/854,111

**Applicant(s)**

WONG ET AL.

**Examiner**

Jason Mitchell

**Art Unit**

2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to a request for continued examination filed 1/18/08

Claims 1-16 are pending in this application.

### ***Response to Arguments***

**Applicant's arguments filed 1/18/08 have been fully considered but they are not persuasive.**

### **Regarding the applicants' statements against the Esquibel reference**

In the 1st par. on pg. 7, the applicants state:

The Examiner has asserted that the Esquibel discloses a converter module storing an extensible set of converter functions. (See 08/25/06 Examiner's Answer, p. 3, line 21 - p. 4, line 1). According to Esquibel, "... any file conversion intermediary can be stored and available for use in format interpreter 118. (See Esquibel, col. 4, lines 48-56). However, while the file conversion intermediary of Esquibel may perform the conversion of a file, the information necessary to perform the conversion of any given file are not stored in the file conversion intermediary or in the format interpreter 118. Initially, it should be noted that the "conversion intermediary" as described by Esquibel is not equivalent to the conversion functions, as recited in claim 1. There is no indication within Esquibel that the conversion intermediary includes or stores an extensible set of instructions necessary to convert one file to a new format. According to Esquibel, the conversion intermediary must receive instructions from a separate source, specifically, from the file specification module 201 of the file. In contrast to the limitations of amended claim 1, the information necessary for converting the file into a new format, according to the Esquibel patent, must be included within the data propagating file structure attached to the file itself, either as an executable module attached to the file or a resource pointer contained within the file.

The examiner respectfully disagrees. Esquibel discloses an embodiment in which the converter functions are represented by executable modules stored in a remote database (see e.g. col. 6, lines 14-26 "a remotely located executable module, which will

perform the file format conversion ... For example, [a] remote database containing executable files.”) A database, by its very nature, is ‘extensible’ (i.e. more files can be added), and the executable modules anticipate ‘sets of instructions’ for converting the files. Thus Esquibel anticipates a converter module “storing an extensible set of converter functions.”

As the applicants have noted, in this embodiment, the file to be converted contains a ‘resource pointer’ (e.g. a URL) identifying the location of the executable module necessary to convert the file to the new format. However it is noted that the claims use ‘comprising’ language and thus do not exclude a resource pointer contained in the file to be converted. In fact Esquibel's use of this ‘resource’ pointer can be reasonably read as an aspect of the claimed “determining a format” of the file.

Further, it is noted that XML documents commonly include similar ‘resource pointers’ (see e.g. “The XML Handbook”, pg. 751, Example 54-2).

**Applicant's arguments with respect to the rejection of claims 1-16 over Rys in view of Esquibel have been considered but are moot in view of the new ground(s) of rejection.**

### ***Claim Objections***

**Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.** Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form. Parent claim 7 has been amended to include "a receiving module". The claimed "receiving element" is not patentably distinct from a "receiving module".

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**Claim 1** recites "a conversion module ... wherein *each of the converter functions* .... provides instructions necessary to *convert each of the plurality of original files to the new files*". Those of ordinary skill in the art would recognize this limitation as describing a set of converter functions each of which is capable, on its own, of converting a file from any one of a plurality of file formats to the new file. The applicants' disclosure describes a set of converter functions where the individual converter functions are each directed to a single original file format (see e.g. par. [0026] "DOM converter 120 may determine that the configuration file is [ in a particular format] and apply the correct conversion function in step 340"). For the purposes of this examination the claim will be

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treated as reading "a conversion module ... wherein ~~each of~~ the converter functions ... provide[[s]] instructions necessary to convert ...each of the plurality of original files to the new files".

**Claims 7 and 12** make similar recitations and are rejected and treated similarly.

**Claims 2-6, 8-11 and 13-16** depend from claims 1, 7 and 12 and are also rejected and treated similarly.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 7-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claim 7** has been amended to additionally recite:

... wherein each of the converter functions within the conversion module provides instructions necessary to convert each of the plurality of original files to the new files; and

a receiving module determining a format of each of the plurality of original files, the receiving module forwarding each of the files to the conversion module based on the determined format for each of the original files, ...

The underlined portions lack sufficient antecedent basis. For the purposes of this examination the claim will be treated as reading:

... wherein each of the converter functions within the conversion module provides instructions necessary to convert the configuration file to the second format; and

a receiving module determining a format of the configuration file, the receiving module forwarding the configuration file to the conversion module based on the determined format for the configuration file, ...

**Claims 8-11** depend from claim 7 and are rejected similarly.

**Claim 12** has been amended to additionally recite:

... determining, by a receiving module, a format of each of the plurality of original files;

forwarding, by a receiving module, the original file to a converter module based on the determined format for each of the original files, the receiving module being separate from the converter module;

applying to the original file, by a converter module, a converter function corresponding to the format of the original file, wherein the converter function is one of an extensible plurality of converter functions stored within the converter module, wherein [] the converter functions within the converter module provide[] instructions necessary to convert each of the plurality of original files to the new files; and ...

The underlined portions lack sufficient antecedent basis. For the purposes of this examination the claim will be treated as reading:

... determining, by a receiving module, a format of the original file;

forwarding, by a receiving module, the original file to a converter module based on the determined format for the original file, the receiving module being separate from the converter module;

applying to the original file, by a converter module, a converter function corresponding to the format of the original file, wherein the converter function is one of an extensible plurality of converter functions stored within the converter module, wherein ... the converter functions within the converter module provide ... instructions necessary to convert the original file to a new file; and ...

**Claims 13-16** depend from claim 12 and are rejected similarly.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 7-11 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**Claim 7** fails to fall within a statutory category of invention. It is directed to a program itself (i.e. A system, comprising only software modules), not a process occurring as a result of executing the program, a machine programmed to operate in accordance with the program or a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. It's also clearly not directed to a composition of matter. Therefor it is rejected as being non-statutory under 35 USC 101.

**Claims 8-11** depend from claim 7 and do not address this issue and are thus also rejected as being non-statutory under 35 USC 101.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2, 4, 6 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,662,186 to Esquibel et al. (Esquibel).**

**Regarding Claim 1:** Esquibel discloses a system, comprising a processor adapted to execute a software package (Fig. 1), the software package, comprising:



a converter module applying a converter function corresponding to a file format of a plurality of original files to create new files in a converted file format (col. 6, lines 11-26 "a remotely located executable module, which will perform the file format conversion in cooperation with the format interpreter 118"), the converter module storing an extensible set of converter functions and the converter function is selected from the extensible set (col. 6, lines 11-26 "a database containing executable files"; note the database can be extended by adding more files), wherein each of the converter functions within the converter module provides instructions necessary to convert each of the plurality of original file to the new files (col. 6, lines 14-19 "perform the file format conversion"); and

a receiving module determining a format of each of the plurality of original files (col. 7 lines 1-4 "the format interpreter 118 (Fig. 1) parses the header 137 and the extension information from the file 136), the receiving module forwarding each of the files to the converter module based on the determined format for each of the original files (col. 6, lines 11-26 "perform the file format conversion in cooperation with the format interpreter 118"; Fig. 4, Steps 401 and 408-409).

Esquibel does not clearly disclose the receiving module being separate from the converter module.

Esquibel teaches the converter module "may be located locally ... or may be located on a server" (col. 6, lines 19-26).

It would, at least, have been obvious to one of ordinary skill in the art at the time the invention was made to provide Esquibel's converter module (col. 6, lines 11-26 "a database containing executable files") separately from the receiving module (col. 7 lines 1-4 "the format interpreter 118). Those of ordinary skill in the art would have been motivated to do so as an obvious alternative method of providing the disclosed functionality (col. 6, lines 11-26 "perform the file format conversion in cooperation with the format interpreter 118"). Such a modification would have resulted in only the expected results (i.e. col. 6, lines 11-26 "a remotely located executable module, which will perform the file format conversion in cooperation with the format interpreter 118 ... the database may be ... access[ed] via a network").

**Regarding Claim 2:** The rejection of claim 1 is incorporated; further Esquibel discloses an application program to access information in the new files, wherein the application program is compatible with the new files and incompatible with the original files. (col. 4, lines 41-43 'Process 106 communicates with format interpreter 118 via connection 122 to analyze and interpret the format associated with file 136')

**Regarding Claim 4:** The rejection of claim 1 is incorporated; further Esquibel discloses the converter function includes a text parser (col. 4, lines 59-62 'The format interpreter 118 will analyze and parse the file extension associated with the file').

**Regarding Claim 6:** The rejection of claim 1 is incorporated; further Esquibel discloses the receiving module determines the format of the original files based on file extensions (col. 4, lines 59-62 'The format interpreter 118 will analyze and parse the file extension associated with the file').

**Regarding Claim 12:** Esquibel discloses a method of converting an original file from a plurality of formats, comprising the steps of:

reading a format of the original file (col. 7 lines 1-4 "the format interpreter 118 (Fig. 1) parses the header 137 and the extension information from the file 136);

determining, by a receiving module, a format of each of the plurality of original files (col. 7 lines 1-4 "the format interpreter 118 (Fig. 1) parses the header 137 and the extension information from the file 136);

forwarding, by a receiving module, the original file to a converter module based on the determined format for each of the original files (col. 6, lines 11-26 "perform the file format conversion in cooperation with the format interpreter 118"; Fig. 4, Steps 401 and 408-409);

applying to the original file, by a converter module, a converter function corresponding to the format of the original file (col. 6, lines 11-26 "a remotely located executable module, which will perform the file format conversion in cooperation with the format interpreter 118"), wherein the converter function is one of an extensible plurality of converter functions stored within the converter module (col. 6, lines 11-26 "a database containing executable files"; note the database can be extended by adding

more files), wherein each of the converter functions within the converter module provides instructions necessary to convert each of the plurality of original files to the new files (col. 6, lines 14-19 "perform the file format conversion"); and

saving the original file in a new file which is in a converted file format created by . the application of the corresponding converter function (col. 5, lines 4-6 'generating the final file that is to be accessed').

**Regarding Claims 13:** The rejection of claim 12 is incorporated; further claim 13 recites limitations similar to those of claim 2 and is rejected accordingly.

**Regarding Claim 15:** The rejection of claim 12 is incorporated; further, Esquibel discloses the plurality of formats of the original files include an extensible markup language (col. 4, lines 49-50 "file formats such as XML").

**Regarding Claim 16:** The rejection of claim 12 is incorporated; further Esquibel discloses the new files are saved in one of random access memory and permanent memory (col. 3, lines 9-39 "data saved in ... another file format ... a random access memory (RAM)").

**Claims 3, 5, 7-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,662,186 to Esquibel et al. (Esquibel) in view of official notice.**

**Regarding Claims 3 and 14:** The rejections of claims 1 and 12 are incorporated respectively; further, Esquibel discloses his system “is applicable to any file format saved on a computer system and is applicable to all computer application programs” (col. 2, lines 53-55) but does not explicitly disclose the converted file format is a document object model tree.

Official notice is taken that ‘document object model trees’ and application programs that act on ‘document object model trees’ were known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Esquibel's conversion system to a prior art configuration file (col. 2, lines 53-55 “any file format ... all computer application programs”). Those of ordinary skill in the art would have been motivated to do so in order to extend the applicability of Esquibel's system to include such configuration files.

**Regarding Claim 5:** The rejection of claim 1 is incorporated; further, Esquibel discloses his system “is applicable to any file format saved on a computer system” (col. 2, lines 53-55) but does not explicitly disclose the original file includes a configuration file.

Official notice is taken that ‘configuration files’ were known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Esquibel's conversion system to a prior art configuration file (col. 2, lines 53-55 "any file format"). Those of ordinary skill in the art would have been motivated to do so in order to extend the applicability of Esquibel's system to include such configuration files.

**Regarding Claim 7:** Esquibel discloses a system (Fig. 1), comprising:

an application module to perform functions (col. 2, lines 53-55 "all computer application programs");

a conversion module applying a converter function to the configuration file to convert the configuration file from a first format incompatible with the application module to a second format compatible with the application module (col. 6, lines 11-26 "a remotely located executable module, which will perform the file format conversion in cooperation with the format interpreter 118"), the conversion module storing an extensible set of converter functions and the converter function is selected from the extensible set (col. 6, lines 11-26 "a database containing executable files"; note the database can be extended by adding more files), wherein each of the converter functions within the conversion module provides instructions necessary to convert each of the plurality of original files to the new files (col. 6, lines 14-19 "perform the file format conversion"); and

a receiving module determining a format of each of the plurality of original files (col. 7 lines 1-4 "the format interpreter 118 (Fig. 1) parses the header 137 and the

extension information from the file 136"), the receiving module forwarding each of the files to the conversion module based on the determined format for each of the original files (col. 6, lines 11-26 "perform the file format conversion in cooperation with the format interpreter 118"; Fig. 4, Steps 401 and 408-409).

Esquibel does not clearly disclose the receiving module being separate from the converter module.

Esquibel teaches the converter module "may be located locally ... or may be located on a server" (col. 6, lines 19-26).

It would, at least, have been obvious to one of ordinary skill in the art at the time the invention was made to provide Esquibel's converter module (col. 6, lines 11-26 "a database containing executable files") separately from the receiving module (col. 7 lines 1-4 "the format interpreter 118"). Those of ordinary skill in the art would have been motivated to do so as an obvious alternative method of providing the disclosed functionality (col. 6, lines 11-26 "perform the file format conversion in cooperation with the format interpreter 118"). Such a modification would have resulted in only the expected results (i.e. col. 6, lines 11-26 "a remotely located executable module, which will perform the file format conversion in cooperation with the format interpreter 118 ... the database may be ... access[ed] via a network").

Further, Esquibel discloses his system "is applicable to any file format saved on a computer system" (col. 2, lines 53-55) but does not explicitly disclose the original file includes a configuration file.

Official notice is taken that configuration files and applications that use information contained in configuration files were known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Esquibel's conversion system to a prior art configuration file used by an application (col. 2, lines 53-55 "any file format ... all computer application programs"). Those of ordinary skill in the art would have been motivated to do so in order to extend the applicability of Esquibel's system to include such configuration files.

**Regarding Claim 8:** The rejection of claim 7 is incorporated; further, Esquibel discloses the conversion module includes a plurality of converter functions corresponding to a plurality of file formats, the first format being one of the plurality of file formats (col. 6, lines 11-26 "a database containing executable files").

**Regarding Claim 9:** The rejection of claim 8 is incorporated; further, Esquibel discloses the conversion module includes a receiving element to determine the first format (col. 7 lines 1-4 "the format interpreter 118").



**Regarding Claims 10:** The rejection of claim 7 is incorporated; further, claim 10 recites limitations similar to those of claim 3 and is rejected accordingly.

**Regarding Claim 11:** The rejection of claim 7 is incorporated; further, Esquibel discloses the first format is an extensible markup language (col. 4, lines 49-50 "file formats such as XML").

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Mitchell whose telephone number is (571) 272-3728. The examiner can normally be reached on Monday-Thursday and alternate Fridays 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bullock Lewis can be reached on (571) 272-3759. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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